

REMARKS/ARGUMENTS

The above-identified patent application has been reviewed in light of the Examiner's Office Action dated December 23, 2009. Claims 1-18 have been amended, and claims 19 and 20 have been canceled, without intending to abandon or to dedicate to the public any patentable subject matter. Accordingly, claims 1-18 are now pending. As set forth herein, reconsideration and withdrawal of the objections to and rejections of the claims are respectfully requested.

Claim Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1-5 and 12-17 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Hattori et al. (US 2003/0132302). In order for a rejection under 35 U.S.C. § 102 to be proper, each and every claim element must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Hattori, however, fails to teach, suggest, or describe several features in the independent and dependent claims. Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. § 102 should be reconsidered and withdrawn.

Claims 6-11 and 18-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hattori in view of Okada (US 2001/0040186). When determining whether a claim is obvious under 35 U.S.C. § 103, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (holding that to establish prima facie obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art)). Moreover, as the Supreme Court recently stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Applicants respectfully submit that several features in the independent and dependent claims are not taught or suggested, either expressly or inherently, in any of the cited prior art references. Accordingly, for at least the reasons below, Applicant submits that the rejection of the claims under 35 U.S.C. § 103 should be reconsidered and withdrawn.

Indeed Hattori does not teach that the transponder has notches (see item 5 of the first office action) even more that the notches are applied at different intervals and/or with a different depth on the various sections of the paper layer in order to create surface regions of different flexibility and/or different flexibility directions.

As such, the claim rejection under 35 U.S.C. § 102 are overcome by the present amendments.

With respect to the claim rejections under 35 U.S.C. § 103, it is submitted that the present amendments also overcome this rejection based on Hattori in view of Okada, which does not suggest the present features.

In Okada 6, indeed the means disclosed to suppress the bending force are directly around the IC chip and are not similar in any manner to the one defined in the amended independent claims 1 or 13.

In addition, Okada does not suggest to form regions with different flexibilities or different flexibility directions with different distances between the grooves as in the present application.

Taking account of the present amendments filed herewith, when considering the overall teaching of Okada, one also notices that in Okada the means used to suppress bending force to the IC chip are in fact directly around the chip (see for example figures 1A and 5A) thus giving the exact position of said chip.

Contrarily, it is one aim of the present invention to avoid giving this position (see the application as filed paragraphs [0015] and [0029]).

It is, therefore, submitted that the subject-matter of the amended claims is neither suggested nor made obvious by the cited prior art combination and, therefore, the pending set of claims appear to be in condition for allowance.

The application now appearing to be in form for allowance, early notification of same is respectfully requested. The Examiner is invited to contact the undersigned by telephone if doing so would be of assistance.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: /Matthew R. Ellsworth/
Matthew R. Ellsworth
Registration No. 56,345
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

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